



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/586,040	08/15/2012	Chongzhao GE	PC11 1414US1	6334

58342 7590 02/02/2017  
WARREN A. SKLAR (SOER)  
RENNER, OTTO, BOISSELLE & SKLAR, LLP  
1621 EUCLID AVENUE  
19TH FLOOR  
CLEVELAND, OH 44115

EXAMINER
----------

HANNETT, JAMES M

ART UNIT	PAPER NUMBER
----------	--------------

2662

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

02/02/2017

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipdocket@rennerotto.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* CHONGZHAO GE, ZHIYUAN CUI, and QINGFA YANG

---

Appeal 2015-008079  
Application 13/586,040  
Technology Center 2600

---

Before CAROLYN D. THOMAS, JEREMY J. CURCURI, and  
NABEEL U. KHAN, *Administrative Patent Judges*.

KHAN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants<sup>1</sup> appeal under 35 U.S.C. § 134(a) from the Final Rejection of claims 1–8. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

---

<sup>1</sup> Appellants identify Sony Mobile Communications AB as the real party in interest. App. Br. 2.

## STATEMENT OF THE CASE

### *The Invention*

Appellants' invention relates to "a camera module, an electronic device comprising the same and an Auto Focus (AF) method. In which the camera module controls an AF according to received direction information of the camera module [sic]." Abstract.

### *References and Rejections*

1. Claims 1–4 and 6–8 stand rejected under 35 U.S.C. § 102(e) as anticipated by Zhou (US 2013/0155266 A1, published June 20, 2013).
2. Claim 5 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Zhou and Velarde (US 2012/0257065 A1, published Oct. 11, 2012).

## ANALYSIS

Appellants do not challenge the merits of the prior art rejections, but instead seek to swear behind the Zhou reference cited in support of each rejection. App. Br. 4 et seq. In doing so, Appellants seek to show reasonable diligence in reducing the invention to practice from just prior to Zhou's prior art date (December 15, 2011), to the filing date of the Chinese application to which this application claims priority (December 31, 2011). *Id.* The evidence provided by Appellants includes a declaration filed under 37 U.S.C. § 1.131 ("Declaration") and an order letter to foreign attorneys, dated November 15, 2011 ("Order Letter"). In Appellants' Declaration, Appellants state "[d]uring the time from at least just prior to December 14, 2011 through December 31, 2011 . . . I worked diligently through my

attorney to finalize and file the current application.” Declaration ¶ 3. Appellants’ Order Letter, sent before the priority date of Zhou, instructs foreign attorneys to draft the Chinese application, send the draft to the inventors for their review, and to file the application by certain suggested dates (*see* Order Letter).

The Examiner finds “the evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Zhou reference to either a constructive reduction to practice or an actual reduction to practice.” Ans. 5–6. We agree with the Examiner that Appellants fail to provide sufficient evidence to establish reasonable diligence for the duration of the critical period from December, 15, 2011, to December 31, 2011. We adopt the Examiner’s findings and conclusions as set forth in the Answer. Ans. 5–7.

Title 37 C.F.R. § 1.131 provides that a party, in certain circumstances, may establish, by a showing of fact, invention prior to a reference applied in a rejection and thus remove that reference as available prior art. In connection with the required showing, 37 C.F.R. § 1.131(b) specifies:

The showing of facts for an oath or declaration under paragraph (a) of this section shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

An applicant must account for the entire period during which diligence is required by either affirmative acts or sufficient excuse for inactivity. *Gould*

*v. Schawlow*, 363 F.2d 908, 918 (CCPA 1966); *Hull v. Davenport*, 90 F.2d 103, 105 (CCPA 1937); *Griffith v. Kanamaru*, 816 F.2d 624, 626 (Fed. Cir. 1987). Although constant effort is not required, there must be some record evidence to explain the delay. *In re Nelson*, 420 F.2d 1079, 1081 (CCPA 1970). Reasonable diligence can be shown if it is established that the attorney worked reasonably hard on the particular application in question during the continuous critical period. *Bey v. Kollonitsch*, 806 F.2d 1024, 1027 (Fed. Cir. 1986).

The evidence presented shows the application was with the foreign attorneys during the critical period. Order Letter 1–2. However, Appellants have not provided any evidence that any specific acts related to the application were actually performed (except filing the application), or if they were, the date that such acts were performed. As the Examiner notes, there is no evidence that the application was shared with the inventors for review or if the inventors had any specific input on the application. Ans. 6. Similarly, no evidence has been presented, in the form of billing records, communications, snapshots of counsel’s docket, or the like, as to when and for how long the foreign attorneys were working on the application, and when they were working on unrelated matters. Appellants must present details of diligence for the present invention. *See e.g., Bey*, 806 F.2d at 1027–28. (“[The] records did not show the exact days when activity specific to *this* application occurred. . . . [T]he attorney has the burden of keeping good records of the dates when cases are docketed as well as the dates when specific work is done on the applications.”)

The only evidence directly related to actions that may have taken place during the critical period is Appellants’ statement in the Declaration

that “[d]uring the time from at least just prior to December 14, 2011 through December 31, 2011 . . . I worked diligently through my attorney to finalize and file the current application.” However, Appellants do not provide any records to corroborate this statement. Given the absence of underlying evidence, we find the Appellants’ statement in the Declaration amounts to a mere pleading and is insufficient to establish diligence. *See In re Harry*, 333 F.2d 920, 923 (CCPA 1964) (“This is not proof or ‘showing of facts’ but mere pleading. It asserts that facts exist but does not tell what they are or when they occurred. The Patent Office must have such facts . . . to judge . . . whether there was diligence.”)

Appellants rely on *Gianladis v. Kass*, 324 F.2d 322, (CCPA 1963), arguing that because a two month period for filing an application has been deemed sufficient for showing diligence, a period of less than two months, as in this case, for filing the Chinese application necessarily shows diligence over the critical period. *See App. Br. 8*. The concern here, however, is not the length of time taken to draft and file the application. Instead the issue is, as explained above, that Appellants have not presented any evidence accounting for the specific actions of either themselves or their attorneys during this duration. In *Gianladis* there was evidence of the attorneys performing a prior art search, correspondence between the attorneys and the inventor regarding the invention, and actions taken by the inventor in pursuing the application. *See Gianladis*, 324 F.2d at 760 (“Both Kass and his attorney from inception engaged in activity directed to an expeditious preparation and filing of the application.”). We lack similar evidence in this case.

For the reasons above, we find that the Examiner correctly determined that the evidence submitted by Appellants is of insufficient weight and character. Because Appellants do not challenge the merits of the rejections, we sustain the Examiner's rejections of claims 1–8.

#### DECISION

The Examiner's rejections of claims 1–8 are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 41.50(f).

AFFIRMED